



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,320	04/03/2001	Gary Liu	10664-147001	4156

26181 7590 06/15/2006

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,320

Applicant(s)

LIU, GARY

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 22-32 and 36-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 22-32, 36-39 and 51 is/are allowed.
- 6) ☒ Claim(s) 4-19, and 40-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Regarding the status of the claims in the instant application, the Examiner has found a 112 second paragraph rejection and a newly found prior art. The Examiner is obliged to apply the newly found rejection. Thus, the finality of the prior office action has been withdrawn and a new rejection follows. The Examiner regrets the delayed process of the application. Accordingly, claims 1-19, 22-32 and 36-51 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, line 5 recites “ an intended recipient”. It should have been – the intended recipient--. Therefore, there is insufficient antecedent basis for this limitation in the claim.

Claim 4, line 8 recites “ to a sender”. It should have been – to the sender--. Therefore, there is insufficient antecedent basis for this limitation in the claim.

Claim 5, line 5 recites “ with a message”. It should have been – with the message--. Therefore, there is insufficient antecedent basis for this limitation in the claim.

Claim 5, line 6 recites “ from an intended recipient”. It should have been – from the intended recipient--. Therefore, there is insufficient antecedent basis for this limitation in the claim.

Claim 7, line 5 recites “ a message”. It should have been – the message--. Therefore, there is insufficient antecedent basis for this limitation in the claim.

Claim 11, line 4 recite “ a message”. It should have been – the message--. Therefore,

there is insufficient antecedent basis for this limitation in the claim.

Claim 11, line 10 recites “ an intended recipient”. It should have been – the intended recipient--. Therefore, there is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 6, 8-10, 17-19, 49 and 50 are rejected under 35 U.S.C. 102 (e) as being anticipated by Feldbau et al (U.S. Pat. No. 6,571,334).

As per claims 6, 8-10, 17-19, 49 and 50 Feldbau discloses a method/apparatus for authenticating that a sender has sent certain information via a dispatcher to a recipient., the method comprising:

Encrypting a message using a symmetric key, sending the encrypted message to an intended recipient without the symmetric key, forwarding the encrypted symmetric key to a third party, and receiving from the third party a certified receipt verified by the third party indicating receipt of the message by the intended recipient (see., abstract, col 1, lines 66 and 67, col 2, lines 1-12, col 4, lines 19-32, col 6, lines 51-67, col 14, lines 66 and 67, col 15, lines 1-15).

Allowable Subject Matter

5. Claims 1-3, 22-32, 36-39 and 51 are allowed over the prior art.

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 03/14/2006 have been fully considered but they are moot in view of new ground (s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Pierre Eddy Elisca

Primary Patent Examiner

May 28, 2006